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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,660	04/06/2001	William R. Shaffer	35867-150907	5705

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EXAMINER

TSAI, HENRY

ART UNIT

PAPER NUMBER

2183

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/828,660

Applicant(s)

SHAFFER, WILLIAM R.

Examiner

Henry W.H. Tsai

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. All the limitations from claims 38-64, such as in claim 38, the "tool comprising a cutting edge that extends from a tip end to a root end, the cutting edge having a controlled hone formed on it which has a shape at the tip end different from the shape at the root end" and in claim 39, "the hone shape varies continuously along the cutting edge from the tip end to the root end" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "66" (on such as page 7); "20" (on such as pages 8 and 9); "166" (on such as page 11); have been used to designate two different parts. A proposed

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drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "150" and "50" (on page 11) have both been used to designate workpiece edge. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "200" (page 8); "84" (page 9); "130" (page 11). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Specification***

5. The disclosure is objected to because of the following informalities: at page 10, line 27, "131" should read -128--,

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line 28, "128" should read -126--. Similar problems exist on the other pages.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 38-64 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As set forth above, all the limitations from claims 38-64, such as in claim 38, the "tool comprising a cutting edge that extends from a tip end to a root end, the cutting edge having a controlled hone formed on it which has a shape at the tip end different from the shape at the root end" and in claim 39, "the hone shape varies continuously along the cutting edge

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from the tip end to the root end" were not shown and described in the specification.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 38-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

All the limitations are not clear since as set forth above, all the limitations from claims 38-64, such as in claim 38, the "tool comprising a cutting edge that extends from a tip end to a root end, the cutting edge having a controlled hone formed on it which has a shape at the tip end different from the shape at the root end" and in claim 39, "the hone shape varies continuously along the cutting edge from the tip end to the root end" were not shown and described in the specification.

In claim 38, line 1, it is not clear how to define "a tip end" and "a root end" since they were not defined and shown.

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Similar problems exist in the other claims, such as claims 41, 42, and 43.

Applicant is required to review the claims and correct all language which does not comply with 35 U.S.C. § 112, second paragraph.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. Claims 38-64, as best understood, are rejected under 35 U.S.C. 102(a) as being anticipated by Johnson (5,876,160).

Johnson discloses the claimed invention comprising, as shown in Fig. 5, a tool comprising a cutting edge(60) that extends from a tip end(see Fig. 8A) to a root end(see Fig. 8B-2), the cutting edge having a controlled hone(64) formed on it which has a shape at the tip end different from the shape at the root end.

Note Johnson also discloses the limitations in claims 39-64, such as in claim 39, the hone shape varies continuously along the cutting edge from the tip end to the root end; and in

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claim 41, the tool having a cutting edge with a hone thereon that varies from a tip end to a root end.

Note as to claim 41, a process comprising the steps of:

"placing the tool in a fixture; rotating an abrasive brush about a rotational axis, the abrasive brush including a plurality of abrasive bristles which define a volume; adjusting the position of the cutting edge relative to the axis of rotation of the abrasive brush such that at least a portion of the cutting edge to be honed is substantially parallel to the axis of rotation of the abrasive brush and in a desired position to be honed; translating the tool along a path substantially parallel to the axis of rotation of the abrasive brush such that a portion of the cutting edge passes through at least a portion of the volume of the abrasive brush to form a hone on the cutting edge having a first shape; adjusting the position of the cutting edge relative to the axis of rotation of the abrasive brush such that another portion of the cutting edge is substantially parallel to the axis of rotation of the abrasive brush and in a desired position to be honed ; and translating the tool along a path substantially parallel to the axis of rotation of the abrasive brush such that said other portion of the cutting edge passes through at least a portion of the volume of the abrasive brush



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to form a hone on the cutting edge having a second shape different from the first shape" does not provide any further structural limitations to the claimed invention since the claimed structure can also be made by the other process, such as grinding and casting steps. Similar are the processes mentioned in claims 42, and 64

#### ***Conclusion***

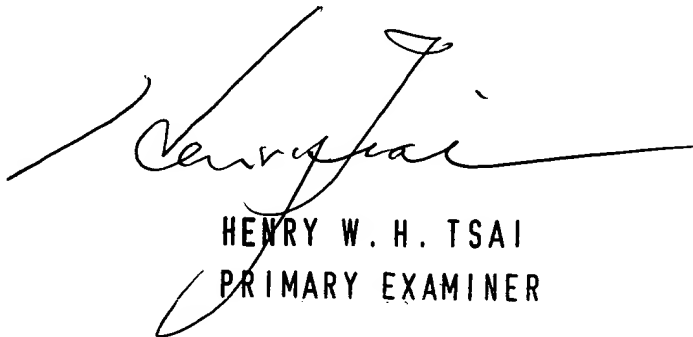
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

#### ***Contact Information***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Henry Tsai whose telephone number is (703) 308-7600. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington can be reached on (703) 308-2159. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703) 308-1148.

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7. In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into: **the Group at fax number 703-872-9302;** and **Official faxes for After Final amendments should be sent to 703-872-9303.** This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3700 will be promptly forward to the examiner.



Handwritten signature of Henry W. H. Tsai in cursive script.

HENRY W. H. TSAI  
PRIMARY EXAMINER

January 25, 2003